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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/908,852	08/08/1997	DONALD CARROLL ROE	5494CR	9941

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THE PROCTER & GAMBLE COMPANY
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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/908,852

Applicant(s)

ROE ET AL. *JH*

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9-13 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9-13 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Withdrawal of Finality

1. In light of the action which follows the finality set forth in Paper No. 40 mailed 6-18-03 is withdrawn.

Specification

2. It is noted that the response filed 4-23-03 did not address cancelled claims 2-3, 8, 14-15, and 27 or pending claims 10-12 as originally filed.

Drawings

3. The drawings were received on 4-23-01. These drawings are approved.

4. It is also noted that the description of Figure 3 on page 5 does not describe Figure 3 as being partly in section or cutaway.

Interpretation of Claim Language

5. The terminology "macroscopic" has not been specifically set forth and therefore is accorded its common, i.e. dictionary, definition, i.e. "large enough to be perceived or examined without instrumentation especially as by the unaided eye". "Absorbent article" and "disposable" are defined as set forth on page 5, lines 18-22. "Semi-solid" is defined as set forth on page 12, lines 24-29. "Effective amount...of a lotion coating" is defined as set forth on page 13, lines 10-15. "Nonuniform" is defined as set forth in the paragraph bridging pages 25-26.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 4-7, 9-13, 16-23 and 25-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,118,041. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the patent and the instant application have the same effective filing date, the one way *In re Vogel* test applies, i.e. are the claims of the instant application obvious in view of the patent claims? The answer is yes. Note col. 10, lines 23-30 of the patent. The claims of the instant application are broader with regard to some aspects and narrower with regard to other aspects of the patent claims. With regard to the broader aspects(e.g. application claims an absorbent article rather than a diaper as the patent does, application doesn't require specifics of some of the immobilizing agents as claimed in the patent), once an applicant has received a patent for a species or more specific embodiment, he is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader, i.e. the patented claims anticipate the application claims. See *In re Goodman*, supra. With regard to the

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narrower aspects(e.g. the last three lines of claim 1, claims 4-7, claims 16-17 which recite specific ranges of open area), the patent claim 1 discloses "at least a portion of the topsheet outer surface comprising an effective amount of a lotion", i.e. open area is less than 100 % of outer surface. Therefore the general conditions of the application claims are disclosed by the patent claims. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation". In re Allen, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus it would not be inventive to find the workable ranges of open area, i.e. the claimed ranges, by routine experimentation.

8. Claims 1, 4-7, 9-13, 16-23 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,426, 444. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the patent and the instant application have the same effective filing date, the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the patent claims? The answer is yes. Note. Col. 10, lines 23-30 of the patent. The claims of the instant application are broader with regard to some aspects and narrower with respect to other aspects of the patent claims. With regard to the broader aspects(e.g. patent claims stripes rather than just elements as do the application claims, application doesn't require specifics of some of the immobilizing agents as claimed in the patent), once an applicant has received a patent for a species or more specific embodiment, he is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader, i.e. the patented claims anticipate the application claims. See In re Goodman, supra. With regard to the narrower aspects(e.g. the last three lines of claim 1, which

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recite a specific range of open area), the patent claim 1 discloses "at least a portion of the topsheet outer surface comprising an effective amount of a lotion", i.e. open area is less than 100 % of outer surface, and spaced stripes. Therefore the general conditions of the application claims are disclosed by the patent claims. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation". In re Allen, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus it would not be inventive to find the workable ranges of open area, i.e. the claimed range, by routine experimentation. Note also patent claims 6, 8 and 12-13.

9. Claims 1, 4-7, 9-13, and 16-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,586,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the patent and the instant application have the same effective filing date, the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the patent claims? The answer is yes. The claims of the instant application are broader with regard to some aspects and narrower with regard to other aspects of the patent claims. With regard to the broader aspects(e.g. application doesn't require specifics of some of the immobilizing agents as claimed in the patent), once an applicant has received a patent for a species or more specific embodiment, he is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader, i.e. the patented claims anticipate the application claims. See In re Goodman, supra. With regard to the narrower aspects(e.g. the last three lines of claim 1, claims 4-7, claims 16-17 which recite specific ranges of open area), the patent claim 1 discloses "at least a portion of the topsheet outer surface

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comprising a lotion", i.e. open area is less than 100 % of outer surface. Therefore the general conditions of the application claims are disclosed by the patent claims. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation". In re Allen, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus it would not be inventive to find the workable ranges of open area, i.e. the claimed ranges, by routine experimentation.

Common Ownership

10. Claims 1, 4-7, 9-13 and 16-26 are directed to an invention not patentably distinct from the claims of commonly assigned 6,118,041 & 6,586,652. Specifically, see double patenting rejections supra.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 6,118,041 & 6,586,652, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

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A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Response to Arguments

11. The Applicant's arguments in the Appeal Brief filed 11-18-03 have been considered but are deemed moot. The Duncan and Buchhalter references alone or in combination do not teach the claimed invention because Duncan teaches the preferred embodiment is a hydrophobic topsheet and therefore it would not be obvious to modify the less preferred embodiment of a hydrophilic topsheet to have the claimed open ranges and Buchalter teaches a moisture not temperature activated composition.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The already cited Dunford reference teaches a topsheet which is hydrophobic during use, i.e. water repellant. The Warner reference '345 teaches a composition and/or composition/tissue combination but the reference does not teach an "effective amount to reduce adherence" but rather functions to impart a soft lubricious lotion like feel to the user. The application 10/386,959, Roe et al application '043, has claims which do not claim the topsheet being hydrophilic as required by the claims of the instant application.

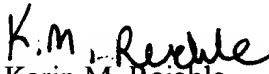
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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617.

The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
January 14, 2004